

Docket No.: 30550/38856A
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Peter J. Malnekoff

Application No.: 09/871,867

Confirmation No.: 2171

Filed: June 1, 2001

Art Unit: 3622

For: AN AUTOMATED GEMSTONE
EVALUATION SYSTEM

Examiner: Retta, Yehdega

REPLY BRIEF

MS Appeal Brief—Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is submitted in response to the Examiner's Answer, filed in this case on December 1, 2006. The Reply Brief is filed within the two-month deadline. Accordingly, this Reply Brief is timely filed.

I. Issues To Be Reviewed On Appeal

This Reply addresses two issues:

Whether Aggarwal Non-Provisional Application Serial No. 09/085,797 or U.S. Patent No. 6,239,867 is available as prior art against the pending claims.

Whether claims 1-18 and 20-22 comply with the written description requirement of 35 U.S.C. § 112, first paragraph.

II. Argument

Having reviewed the file history, the Appeal Brief and the Response, the Applicant intends to focus on a few narrow issues in this Reply. This is not to ignore or forfeit the arguments made previously and not repeated here, but is to focus on the issues that the Applicant believes are the most clear, are easy to understand and will quickly resolve this appeal and not waste the Board's time by refuting every statement made in the Response.

A. The Aggarwal Non-Provisional And Aggarwal Patent are not available as prior art because the provisional application from which Aggarwal claims priority to does not support the subject matter relied upon to reject the pending claims.

The Aggarwal non-provisional Application Serial No. 09/085,797 and Aggarwal U.S Patent No. 6,239,867, which resulted from a continuation application of the 09/085,797 application, are not available as a prior art reference because the subject matter of 09/085,797 and 6,239,867 relied upon by the Office actions to reject the pending claims have an effective prior art date of May 28, 1998, and the Applicant has sworn behind this date in a previous Rule 131 declaration.

The chronology of the Aggarwal applications and patent are as follows:

Aggarwal Provisional Application filed December 18, 1997;
Aggarwal Non-Provisional Application No. 09/085,797 filed May 28, 1998; and

Aggarwal Continuation Application No. 09/455,643 filed December 7, 1999, which issued as U.S. Patent No. 6,239,867 on May 29, 2001.

The Aggarwal provisional application (No. 09/085,797) does not contain support for the subject matter in the Aggarwal non-provisional (Application Serial No. 09/085,797) or Aggarwal patent (U.S. Patent No. 6,239,867) that is relied upon by the Office actions to reject the pending claims, as required by 35 U.S.C. § 112, first paragraph. See, MPEP § 2136.03 IV, (“Filing Date Of U.S. Patent Application Can Only Be Used As The 35 U.S.C. § 102(E) Date If It Supports The Claims Of The Issued Child”). See also, *In re Wertheim*, 646 F.2d 527, 537 (CCPA 1981):

If, for example, the PTO wishes to utilize against an applicant a part of that patent disclosure found in an application filed earlier than the date of the application which became the patent, it must demonstrate that the earlier-filed application contains §§ 120/112 support for the invention claimed in the reference patent.

Because the Aggarwal provisional application does not support the relied upon sections of either the Aggarwal non-provisional application (09/085,797) or Aggarwal patent (6,239,867), the earliest filing date that can be afforded the Aggarwal non-provisional application and Aggarwal patent to anticipate an application claim is May 28, 1998.

Specifically, the Office actions rely on Aggarwal column 16, lines 28-38 to disclose associating a price range with the characteristics of analyzed gemstones. It is this disclosure that the Office action asserts against claims 1, 8 and 15 for disclosing computing a “pricing estimate” for use in an “evaluation report” based upon data on the gemstone laboratory grading certificate, such as cut proportions. The Aggarwal provisional (60/068,033) fails to include this paragraph or otherwise support this disclosure. Moreover, the Aggarwal provisional fails to disclose, in any manner, computing a “pricing estimate.” While the Aggarwal provisional mentions the phrase “monetary value,” “appraisal report” and “aesthetic value” when discussing evaluation of gemstone qualities, the Aggarwal provisional only describes determining gemstone quality factors, such as color, clarity, cut shape, brilliance, etc. Moreover, while these features may be related to the monetary value of a gemstone, the Aggarwal provisional fails to specifically disclose computing a “price estimate” which, unlike the appraisal described in the Aggarwal provisional, includes an adjustment factor.

The only disclosure of a price determination is made in the Aggarwal patent filed on May 29, 1998, and its continuation application filed May 29, 2001. In regards to this disclosure, a declaration by Applicant Peter J. Malnekoff pursuant to 37 C.F.R. § 1.131 ("the Rule 131 Declaration") was filed on August 26, 2003. The Rule 131 Declaration demonstrates that the invention claimed in this application was conceived by Mr. Malnekoff prior to May 28, 1998, and that Mr. Malnekoff was reasonably diligent in reducing the invention to practice. In the Office action dated November 18, 2003, the examiner indicated that the Rule 131 declaration "has been considered but is ineffective to overcome the Aggarwal reference," and the Examiner persists in citing the Aggarwal patent in the claim rejections.

Applicant again respectfully, but vehemently, states that this disclosure material relied upon by the Examiner from the Aggarwal patent is absent from the Aggarwal provisional patent application. In the Response, the Rejection now points to Page 3 line 26 to page 4, line 7, page 6 lines 25-30 and pages 13 lines 24 to page 14 lines 3 along with Fig. 21. The closest quote is on pages 13 and 14 where an appraisal report is mentioned. The key section of the Aggarwal patent (Col. 16, lines 28-38 which discusses looking at market prices to provide better appraisals) is still missing from the Aggarwal non-provisional.

As explained in the patent application itself, the claimed "evaluation report" is an improvement over an appraisal. The term "evaluation report" (which contains the pricing estimate) as opposed to "appraisal" was used for a reason because the two are different. The "evaluation report" takes more into account than an appraisal and uses an adjustment factor to compensate for a variety of factors such as lab grading habits. The adjustment factor is absent from the Aggarwal provisional. Accordingly, the Aggarwal provisional fails to disclose what is claimed and cannot be used to reject the pending claims. Thus, the effective date of such teachings of the Aggarwal patent do not extend back to the filing date of the Aggarwal provisional application (December 18, 1997), but instead only are entitled to an effective date of May 28, 1998, the filing date of the nonprovisional application from which the Aggarwal reference is a continuation. Accordingly, the Aggarwal patent is not entitled to be used as prior art over the present application.

B. Claims 1-18 and 20-22 comply with the written description requirement of 35 U.S.C. 112, first paragraph.

The Applicant is very surprised the 112 first paragraph rejection is still present. As exhaustively described in the Appeal Brief, the drawings and specification certainly support the pending claims. Without belaboring the point and wasting the Board's time, the Applicant is left to wonder what would be sufficient? Does an Applicant have to describe the intricate details of the http and TCP/IP protocols used access the Internet? The equations necessary to describe how lights flows through fiber optic cables?

Claim 1 recites "an input device adapted to receive a gemstone laboratory grading certificate via a remote communication device." The Response asserts that a gemstone laboratory grading certificate is considered new matter because the specification does not teach an input device receiving the gemstone laboratory grading certificate via a remote communication device. Applicants respectfully traverse the rejection because Figure 2 and the corresponding specification at page 6, lines 15 – page 7, line 27 support receiving a gemstone laboratory grading certificate via a remote communication device.

In one embodiment, the remote communication system 18 of Fig. 2 is described as a shared public network such as the Internet (See page 6, lines 24-27). Moreover, the specification describes that processing device 14 may be in communication with a number of potential users, or devices, over the remote communication system 18 (See page 7, lines 24-27). While Applicants submit that the language of receiving a laboratory grading certificate is supported, receiving gemstone data from a laboratory grading certificate is explicitly described on page 9, lines 7-16. Therefore, the rejection of claim 8, and claims 9-18 and 21 depending therefrom, is improper.

Claim 20 complies with the written description of 35 U.S.C. 112, first paragraph. The Response asserts that the specification does not "disclose allowing a user to modify a value of any of the physical characteristics of the gemstone and adjusting the fair market pricing estimate based on the modified value," and thus considers this element new matter. The Figure 5 and the specification at page 9, lines 24-26 and page 9, line 3 – page 10, line 1 discusses that a baseline price estimate is determined based on physical characteristics. Adjustments to this baseline estimate is disclosed at least on page 9, lines 24-26; page 10 lines 3-8; page 10 lines 21-25. The determination of the baseline price and the adjustment can be performed automatically by a computer, as summarized on page 13, lines 13-17 and

Fig. 2. Claim 20 recites changing the value of a physical characteristic and adjusting a first price estimate based on the modified value. This is fully supported by the text as one skilled in the art recognizes that any changes in the input parameters can automatically cause a corresponding adjustment at the output of the system. Thus, changes to a physical characteristic value will effect the output of an automated process. Therefore, allowing a user to modify a value of any of the physical characteristics of the gemstone and adjusting the fair market pricing estimate based on the modified value is disclosed by the specification.

Conclusion

In view of the foregoing remarks, it is respectfully submitted that each of claims 1–18 and 20–22 is patentable over the prior art, and that all of the pending claims should be allowed.

Respectfully submitted,

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